

REMARKS

Claims 27-30, 33, 35, 37-39, 53-63, and 65 are pending. Claim 36 is cancelled.

Claims 1, 54, and 60 are amended. Support for the amended claim 1 can be found throughout the specification, particularly pages 3-8. The amendment to Claims 54 and 60 are to correct minor typographical errors. Amendment to claim 54 is to overcome 35 U.S.C. § 112.

Favorable reconsideration is respectfully requested in light of the following remarks.

1. Rejection of Claims 27-30, 37, 39, 53, 54, 56-59 and 63 under 35 U.S.C. § 102 (b) as being anticipated by WO 99/63157.

The independent claim 27 is amended to recites that the ink receptive layer has at least one biocide; and a holdout layer that is disposed between the base layer and the ink receptive layer, wherein the holdout layer comprises starch." (Emphases added). The Examiner admits that WO 99/63157 fails to teach that the ink receiving layer has a biocide. Therefore, the amended claim 27 is not identically taught or described in WO 99/63157 and thus, claim 27 is not anticipated by the WO 99/63157. Therefore, the amended claim 27 defines a patentable subject matter and claims 28-30, 32, 33, 35-39, 53-59, 63, and 65 are dependent directly or indirectly upon claim 27 and therefore inherit each and every element of the parent claim and any intervening claim(s). Applicants respectfully request withdraws of the rejection.

2. Rejection of Claims 33, 38, 55 and 65 under 35 USC § 103(a) as being unpatentable over WO 99/63157.

Claims 33, 38, 55 and 65 are directly dependent on the amended claim 27. The inapplicability of WO 99/63157 to the patentability of the amended claim 27 is noted hereinabove and attention is invited to such discussions. Therefore, the amended claim 27 defines a patentable subject matter and each of claims 33, 38, 55 and 65 is dependent directly

upon the claim 27 and therefore inherits each and every element of their parent claim and any intervening claim(s).

Accordingly, WO 99/63157 fails to disclose or suggest the claimed invention. Applicants respectfully request withdrawal of this ground of rejection.

3. Rejection of Claims 35 and 36 under 35 USC § 103(a) as being unpatentable over WO 99/63157 taken in view of Malhotra (5709976).

Since claim 36 is cancelled, then the rejection of claim 36 is rendered moot. With respect to dependent claim 35 which is directly dependent on the amended claim 27, the Applicants submit that the inapplicability of WO 99/63157 to the patentability of the amended claim 27 is noted hereinabove and attention is invited to such discussions.

With respect to **Malhotra**, it should be noted that the coated paper in **Malhotra** includes a hydrophobic barrier layer where an image receiving coating situated on top of both hydrophobic barrier layers. **Malhotra** is directed to an ink jet printing paper which includes a "hydrophobic barrier layer" and an image receiving coating. This "hydrophobic barrier layer" is not identical or equivalent to Applicants' claimed hold out layer comprises starch. **Malhotra**'s barrier layer includes both a water insoluble component (such as polyurethanes, polysilanes, and monomeric silanes) and a water or alcohol soluble anticurl agent. However, **Malhotra** makes no mention or suggestion of a starch in his "hydrophobic barrier layer". **Malhotra** does describe the use of starches as a part of the composition of his image receiving coating layer. However, this would not suggest to one of ordinary skilled in the art the use of starch in a hold out layer which is separate or distinct from any ink or image receptive layer.

These differences are not surprising giving the entirely different goals of Applicants' invention and that of **Malhotra**. Applicants' invention provides a substantially inflexible

paperboard material which may be used for file folders and other related storage articles and which exhibit improved durability and resistance to damage and staining if contacted with water during long-term storage or with beverages such as coffee when in use in an office environment.

Malhotra's efforts, in contrast, are directed to papers (as opposed to heavier paperboards) which have relatively low basis weights and which have substantial flexibility to be processed in either ink jet or electrostatic printing apparatus. Malhotra's specific goal is to provide coatings which "fix" ink jet printing inks on such papers so that the ink does not "run" or "bleed" from one side of the paper to the other.

In sum, therefore, Malhotra describes a significantly different coated paper structure, intended for different purpose, which does not describe or suggest Applicant's claimed invention.

In light of the foregoing, Applicants urge the Examiner to reconsider the present invention, to withdraw the rejections, and to issue a notice of allowance at the earliest possible convenience.

4. Rejection of Claims 60-62 under 35 USC § 103(a) as being unpatentable over WO 99/63157 in view of Malhotra (5709976) and further taken in view of EP 880892.

Claims 60-62 are directly dependent on the parent claim 27. The inapplicability of WO 99/63157 to the patentability of amended claim 27 is noted hereinabove and attention is invited to such discussions.

Thus, irrespective of what EP 880892 teaches with respect to the chemistry that is used in the paper coatings, the failure of WO 99/63157 as a primary reference negates the combination of Malhotra (5709976) in view of EP 880892 as a basis for rejection of

dependent claims 60-62 of the present claimed invention. Therefore, this rejection is inappropriate and should be withdrawn.

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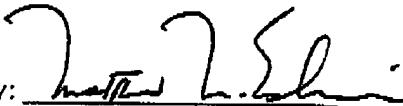
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CONCLUSION

Therefore, Applicants respectfully submit that the amended independent claim 27 particularly define and patentably distinguish the present invention over the cited references. In addition, all of the dependent claims which depend from claim 27 also define a patentable subject matter. Accordingly, reconsideration of the rejections and allowance of claims 27-30, 33, 35, 37-39, 53-63, and 65 is earnestly requested. However, should the Examiner have any remaining questions and the attending to of which would expedite such action, the Examiner is invited to contact the undersigned at the telephone number listed below.

One month extension of time is believed to be required. The Commissioner is authorized to charge any fees associated with this or any other communication, or credit any over payment, to Deposit Account No. 09-0525.

Respectfully submitted,

By: 

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Matthew M. Eslami
Reg. No. 45,488
Patent Agent for Applicants
International Paper Company
6285 Tri-Ridge Boulevard
Loveland, Ohio 45140
Tel: (513) 248-6193
Fax: (513) 248-6455
e-mail: matt.eslami@ipaper.com